

Remarks

A. Claims in the Case

No claims have been amended. Claims 1-39 are pending.

B. Specification

The Examiner objected to the specification at page 21, line 23 because of an informality. The specification has been amended for clarity. Applicant respectfully requests the Examiner withdraw the objection to the specification.

C. 35 U.S.C. § 103(a) Rejections

The Examiner has rejected claims 1-8, 10-11, 13, 15, 17-26, and 29-34 under 35 U.S.C. § 103(a) as being unpatentable over PXI Specification (Revision 1.0, August 20, 1997) (hereinafter "PXI Specification") in view of InfiniBand Architecture Specification (Volume 1, Release 1.0, October 24, 2000) (hereinafter "InfiniBand Specification"). Applicant respectfully disagrees with these rejections.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner* et al., 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

PXI Specification and InfiniBand Specification do not appear to disclose, teach, or suggest "a switched fabric bus; and a plurality of instrumentation signaling lines which provide

instrumentation signaling functions” as recited in claims 1 and 35. Applicant respectfully submits that the Infiniband Specification does not appear to suggest using the Infiniband bus with instrumentation lines. Applicant also respectfully notes:

Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor. (*ATD Corporation v. Lydall, Inc.*, 48 USPQ 2d 1321, 1329 (Fed. Cir. 1998)).

Furthermore, the Office Action has not stated a prima facie case of obviousness for combining the PXI Specification and the InfiniBand Specification. As stated in the MPEP §2142:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added)

There is no teaching or suggestion to combine PXI Specification and the InfiniBand Specification either in the references or in the prior art. As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis.

Furthermore, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching

of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. Applicant respectfully asserts that there is no suggestion in the prior art for combining and, and that even were the two references combined, they would not produce the system of at least claims 1-39. Applicant respectfully requests the Examiner withdraw the rejection to claims 1, 35, and claims dependent thereon.

The Examiner has rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over PXI Specification in view of InfiniBand Specification in further view of Doblar et al. (U.S. Pub. No. 2001/0013100) (hereinafter "Doblar"). Applicant respectfully disagrees with these rejections.

Applicant respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claim 9 is allowable for at least the above reasons.

The Examiner has rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over PXI Specification in view of InfiniBand Specification in further view of Lee et al. (U.S. Pat. No. 5,040,158) (hereinafter "Lee"). Applicant respectfully disagrees with these rejections.

Applicant again respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claim 12 is allowable for at least the above reasons.

The Examiner has rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over PXI Specification in view of InfiniBand Specification in further view of Bell et al. (U.S. Pat. No. 6,356,140) (hereinafter "Bell"). Applicant respectfully disagrees with these rejections.

Applicant again respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claim 14 is allowable for at least the above reasons.

The Examiner has rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over PXI Specification in view of InfiniBand Specification in further view of Ohta et al. (U.S. Pat. No. 5,414,635) (hereinafter "Ohta"). Applicant respectfully disagrees with these rejections.

Applicant again respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claim 16 is allowable for at least the above reasons.

The Examiner has rejected claims 27-28 under 35 U.S.C. §103(a) as being unpatentable over PXI Specification in view of InfiniBand Specification in further view of Shaffer et al. (U.S. Pat. No. 6,349,286) (hereinafter "Shaffer"). Applicant respectfully disagrees with these rejections.

Applicant again respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claims 27-28 are allowable for at least the above reasons.

The Examiner has rejected claims 35-39 under 35 U.S.C. §103(a) as being unpatentable over InfiniBand Specification in view of PXI Specification. Applicant respectfully disagrees with these rejections.

Applicant again respectfully asserts that that Examiner appears to be combining references with improper hindsight based on the Applicant's disclosure. Applicant respectfully asserts claims 27-28 are allowable for at least the above reasons.

D. Additional Remarks

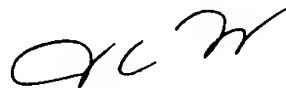
Based on the above, Applicant submits that all of the claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel Deposit Account No. 50-1505/5150-51201/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



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